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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/142,095	11/02/1998	BRIAN BURCHELL	MUR-7450	1739

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EXAMINER

SHEINBERG, MONIKA B

ART UNIT PAPER NUMBER

1634

DATE MAILED: 12/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/142,095

Applicant(s)

BURCHELL, BRIAN

Examiner

Monika B Sheinberg

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment F***

Applicants' arguments, filed 11 September 2002, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 15-22 are pending.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15-18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosma et al (*N. Engl. J. Med.*, 1995) in view of Comings (US Patent 5,260,196; 9 November 1993); and further in view of Sibille et al (*Eur. J. Clin. Pharmacol.*, 1990).

Bosma et al teaches the genetic basis of the reduced expression of bilirubin UDP-glucuronosyltransferase 1 (UGT1) in Gilbert's Syndrome by the amplification of the specific regions of (TA)<sub>6</sub>TAA and (TA)<sub>7</sub>TAA for genotyping homozygous and heterozygous subjects of the TATAA element as recited in claims 15 and 21. As required by claim 18, Bosma et al demonstrates the collection of blood for sample analysis (p. 1172, line 6). Figure 1 of page 1173, demonstrates the use of detectable labeled primers (claim 20) by the visualization of the amplified products that were sequenced directly.

Bosma et al does not teach the buccal smear as the source of a biological sample (claim 19). Comings demonstrates obtaining DNA from buccal smears for genetic analysis (column 5, lines 54-56).

Art Unit: 1634

Bosma et al does not teach a test in clinical drug trials that involves screening of the genetic basis for Gilbert's Syndrome (claims 16, 17 and 21). Sibille et al teaches a laboratory screening method for the selection of healthy volunteers. Specifically, Sibille teaches:

the aim of laboratory screening in phase I is to exclude subjects with subclinical illness, who might be at increased risk in the study, and who might also adversely influence interpretation of the results (Summary, p. 475).

In addition, the screening is carried out on the basis of abnormal levels of bilirubin, which found in patients with Gilbert's Syndrome (Table 3, p. 477).

Bosma et al does not teach the specific primers required for amplification (claims 15 and 22), however the primers taught by Bosma et al flank the same region of interest as the instant application and further detect the genotype. Thus the primers of Bosma et al are functionally equivalent to the instant application. It would be obvious for one of ordinary skill in the art at the time the invention was made to obtain a number of primer pairs that would be able to amplify the region in question to obtain the claimed invention absent evidence to the contrary.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to perform the analysis of genetic basis for Gilbert's syndrome specific to the TATAA elements as taught by Bosma et al and further modify the biological sample collection to included buccal smears as per the teachings of Comings. It would have further been obvious to have modified the method of Bosma et al to include the genetic analysis method for clinical trials as per the teachings of Sibille et al. Thus, one of ordinary skill in the art would have been motivated to combine the teachings of Bosma et al and Sibille et al due to the advantages of excluding subjects from a drug trial whose illness, albeit benign or not, might result in adverse affects upon the subject and/or test results in a drug trial. Thus it would have been obvious to screen candidates for Gilbert's Syndrome, as this condition would have led to skewed and inaccurate results at best, and may have also been to the detriment of the subject's health.

### ***Conclusion***

No claim is allowed.

Application/Control Number: 09/142,095

Page 4

Art Unit: 1634

*Inquiries*

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 1 P.M to 8 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Chantae Dessau, whose telephone number is (703) 605-1237, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 2, 2002

Monika B. Sheinberg  
Art Unit 1634

*MBS*



JEHANNE SOUAYA  
PATENT EXAMINER